

In response, the Applicants have provided a specific definition for the phrase and further note that the phrase should be commonly understood by those skilled in the art. As such, Applicants request the rejection under 35 U.S.C. §112, second paragraph, be withdrawn.

Rejections Under 35 U.S.C. §103

Claims 1, 2, 6, 10 and 14-16 currently stand rejected as being unpatentable over Toosky in view of Schumacher. The Examiner states that Toosky discloses a nut having an insert which is shown at least in one embodiment to be a helically coiled wire. Further, the Examiner notes that the insert, when plated with silver or another suitable metal, serves to prevent galling.

The Examiner goes on to note that Schumacher appears to disclose an alloy including each of the elements, included in the stainless steel alloy used to form the inserts of the present invention. Thus, the Examiner concludes that it would have been obvious for one of ordinary skill in the art to make the insert of Toosky out of a material as disclosed in Schumacher because one of ordinary skill in the art would find it preferable to use an anti-galling alloy as opposed to a separate coating or plating as described by Toosky.

Initially, Applicants note that in order to support a rejection under 35 U.S.C. §103, the Examiner must establish that there is some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability, and, thus, the obviousness, of making the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988). That is, although the Examiner may suggest that

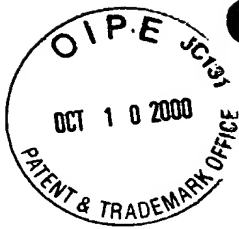
the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the *desirability* of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir. 1989). Applicants respectfully traverse the rejection of Claims 1, 2, 6, 10 and 14-16 for at least the following reasons.

Applicants respectfully submit that Toosky completely fails to teach or suggest the possibility of manufacturing an anti-galling fastener insert which is not plated. Absent this specific teaching by the prior art of record, the Examiner's proposed combination and rejection under §103 are believed to be inappropriate. Further, even if the Examiner maintains that the combination of Toosky and Schumacher is appropriate, the Examiner has recognized that the prior art of record has failed to reveal threaded fastener assemblies formed from alloys employing the relatively large amounts of manganese and silicon in combination with the other disclosed elements.

In view of the foregoing, Applicants request the rejection of Claims 1, 2, 6, 10 and 14-16 be withdrawn at this time.

Claims 3-5, 7-9, 11-13 and 17-19 currently stand rejected under 35 U.S.C. 103(a) as being unpatentable over Toosky as applied to Claims 1, 2, 6, 10, 14 and 16 above and further in view of Cosenza. Cosenza teaches the insert having the same shape as that claimed by applicant is shows the diamond-shaped cross-section and the 60° internal screw thread convolution. The Examiner believes it would have been obvious for one of ordinary skill in the art to make the insert of Toosky of a shape as disclosed in Cosenza because the shape of the insert of Cosenza provides for superior thread engagements.

Applicants also respectfully traverse the rejection of Claims 3-5, 7-9, 11-13 and 17-19. Since each of these claims are dependent from claims which should be in a condition for allowance, also allowable are the claims which depend therefrom. Each of the dependent claims are to be read to include the limitation of an anti-galling fastener insert



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formed from a specific alloy which does not require plating to accomplish the anti-galling characteristic.

In view of the foregoing, this application should be in condition for allowance and such action is respectfully requested. If the Examiner believes that personal contact would be advantageous to the disposition of this case, he is respectfully requested to contact the undersigned at his earliest convenience.

Respectfully submitted,

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